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| APPLICATION NO.                                     | FILING DATE | FIRST NAMED INVENTOR  | ATTORNEY DOCKET NO.             | CONFIRMATION NO.            |
|---|-------------|-----------------------|---------------------------------|-----------------------------|
| 10/659,629  | 09/09/2003  | Anthony J. Baerlocher | 0112300-1634                    | 5599                        |
| 29159   | 7590        | 05/14/2009            |                                 |                             |
| K&L Gates LLP<br>P.O. Box 1135<br>CHICAGO, IL 60690 |             |                       | EXAMINER<br>LEIVA, FRANK M      |                             |
|   |             |                       | ART UNIT<br>3714                | PAPER NUMBER                |
|   |             |                       | NOTIFICATION DATE<br>05/14/2009 | DELIVERY MODE<br>ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/659,629 | <b>Applicant(s)</b><br>BAERLOCHER ET AL. |  |
|                              | <b>Examiner</b><br>FRANK M. LEIVA    | <b>Art Unit</b><br>3714                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35 and 44-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 and 44-60 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 December 2008 has been entered.

### ***Acknowledgements***

2. The examiner acknowledges claims 1-6, 8-11, 21-24, 26-27, 31-33, 35, 44, 47, 49, 52, 55 and 58 have been amended in applicant's submission filed 12 December 2008.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 1-35, 44-60 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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**5. Claims 1-35, 44 and 47-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Thomas et al. (US 6,190,255 B1).**

**6. Regarding claims 1, 21 and 35;** Thomas discloses a gaming device comprising an input device, a display device, a processor and a memory device which stores a plurality of instructions, which when executed by the processor, cause the processor to operate with the display device and the input device, (fig. 14 and col. 2:7-19), to:

(a) select and display at least one of a plurality of different outcomes of first round, (col. 10:25-26 and col. 10:46-48); (b) select one of said-a plurality of different probabilities of providing a winning outcome of a second round, wherein said probability of providing said winning outcome of said second round is selected based exclusively on the number of non-selected outcomes of said first round, (col. 10:57-11:13 and col. 14:5-49); (c) determine whether to provide a player the winning outcome of the second round, wherein said determination is based on the selected probability of providing said winning outcome of said second round, (col. 10:57-11:13); and (d) display an award based on at least one of the selected outcomes of the first round and any (positive/winning) outcome of the second round, wherein said award is determined independent of any base game outcome, (col. 11:1-13).

**7. Regarding claims 2 and 12;** Thomas discloses wherein when executed by the processor, said plurality of instructions cause said processor to provide the player an award based on the selected outcome of said first round and the winning outcome of said second round if said determination is to provide the player the winning outcome of said second round, (col. 11:1-13).

**8. Regarding claims 3 and 13;** Thomas discloses wherein when executed by the processor, said plurality of instructions cause said processor to provide the player an award based on the selected outcome of the first round if said

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determination is not to provide the player the winning outcome of said second round, (col. 11:1-13).

**9. Regarding claims 4 and 14;** Thomas discloses wherein when executed by the processor, said plurality of instructions cause the processor to enable the player to play the first round, (col. 9:4-13).

**10. Regarding claims 5 and 15;** Thomas discloses wherein when executed by the processor, said plurality of instructions cause the processor to enable the player to play the second round, (col. 10:64-67).

**11. Regarding claims 6 and 16;** Thomas discloses wherein when executed by the processor, said plurality of instructions cause the processor to enable the player to play the first round and the second round, (col. 10:46-67).

**12. Regarding claims 7 and 17;** Thomas discloses which includes at least one subsequent round, at least one winning outcome of said subsequent round and a plurality of different probabilities of providing said winning outcome of said subsequent round, (col. 14:5-49).

**13. Regarding claims 8 and 18;** Thomas discloses wherein when executed by the processor, said plurality of instructions cause the processor to select one of the probabilities of providing said winning outcome of said subsequent round based on the selected outcome of said first round and determine whether to provide the player the winning outcome of said subsequent round based on the selected probability of providing said winning outcome of said subsequent round, (col. 14:5-49).

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**14. Regarding claims 9 and 19;** Thomas discloses wherein when executed by the processor, said plurality of instructions cause the processor to select one of the probabilities of providing said winning outcome of said subsequent round based on the selected outcome of said second round and determine whether to provide the player the winning outcome of said subsequent round based on the selected probability of providing said winning outcome of said subsequent round, (col. 14:5-49).

**15. Regarding claims 10 and 20;** Thomas discloses wherein when executed by the processor, said plurality of instructions cause the processor to select one of the probabilities of providing said winning outcome of said subsequent round based on the selected outcome of said first round and said second round and determine whether to provide the player the winning outcome of said subsequent round based on the selected probability of providing said winning outcome of said subsequent round, (col. 14:5-49).

**16. Regarding claims 11 and 22;** Thomas discloses a gaming device comprising a primary wagering game operable upon a wager by a player, a first round, a plurality of different outcomes of said first round; a second round; a winning outcome of said second round, a plurality of different probabilities of providing said winning outcome of said second round; and a triggering event associated with said primary wagering game, wherein after the occurrence of said triggering event, (abstract and col. 14:5-49); (a) one of said plurality of outcomes of said first round is selected and displayed, (col. 10:46-50); (b) one of said different probabilities of providing said winning outcome of said second round is selected, wherein said probability of providing said winning outcome of said second round is selected based exclusively on the number of non-selected outcomes of said first round, (col. 14:5-19); (c) a determination of whether to provide the player the winning outcome of the second round occurs, wherein said determination is based on the selected probability of providing said winning outcome of

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said second round, (col. 10:46-67); and (d) display an award based on at least one of the selected outcomes of the first round and any (positive/winning) outcome of the second round, wherein said award is determined independent of any base game outcome, (col. 10:4-13), wherein the outcome award of the bonus game is only dependent of the coins played not on the outcome of the base game.

**17. Regarding claims 23, 27, 31, 33, 44, 47, 52 and 58;** Thomas discloses a gaming device comprising an input device, a display device, a processor and a memory device which stores a plurality of instructions, which when executed by the processor, cause the processor to operate with the display device the input device, (fig. 14 and col. 2:7-19), to: (a) indicate at least one of a range of different independently determined values of a first round to a player, (b) select one of a range of different probabilities of obtaining a modifier of a second round, (col. 5:57-62 and 14:53-58) wherein the greater the indicated value of said first round the lower the selected probability of obtaining said modifier of said second round, (col. 14:5-49), since the number of good outcomes is less in comparison with the end-bonus symbol the good outcome rate is lowered; (c) determine whether to provide the player said modifier of said second round, wherein said determination is based on the selected probability of obtaining said modifier of said second round, (col. 14:5-49), (d) provide the player the indicated value of the first round if the determination is not to provide the player said modifier of said second round, (e) modify the indicated value of said first round by said modifier of the second round if the determination is to provide the player said modifier of said second round, and (f) display said modified value, wherein said modified value is determined independent of any base game outcome, (col. 11:1-13).

**18. Regarding claims 24, 28 and 32;** Thomas discloses wherein when executed by the processor, said plurality of instructions cause said processor to provide the player any modified value, (col. 7:29-31).

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**19. Regarding claims 25 and 29;** Thomas discloses wherein said first round includes a plurality of opportunities to obtain said values, wherein each of said opportunities is associated with a probability of obtaining one of said values, (col. 10:25-28).

**20. Regarding claims 26 and 30;** Thomas discloses wherein when executed by the processor, said plurality of instructions cause said processor to provide the player at least one of said plurality of opportunities and to determine based on the associated probability for each provided opportunity whether to indicate one of said values, (col. 10:46-50).

**21. Regarding claims 48 and 54;** Thomas discloses which includes a plurality of terminators, (col. 5:52-54).

**22. Regarding claims 49 and 55;** Thomas discloses wherein when executed by the processor, said plurality of instructions cause the processor to provide the player one of said terminators in the first round if the player's picked selection is not associated with said selected value, (col. 14:5-49).

**23. Regarding claims 50 and 56;** Thomas discloses wherein said terminating event occurs when the player is provided a designated number of terminators, (col. 14:5-49).

**24. Regarding claims 51 and 57;** Thomas discloses wherein the higher the number of un-revealed values of said first round, the lower the probability of obtaining said modifier of said second round, (col. 14:5-49 and fig. 11), %-safe value decreases with each consecutive choice.

**25. Regarding claim 53;** Thomas discloses wherein said terminating event occurs when the steps are repeated for a designated number of opportunities, (col. 13:52-60).



***Claim Rejections - 35 USC § 103***

**26.** The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**27. Claims 45-46 and 59-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas.**

**28. Regarding claims 45-46 and 59-60;** Thomas discloses wherein the higher the number of non-provided values of said first round, the lower the probability of obtaining said modifier of said second round, (col. 14:5-49 and fig. 11) wherein the higher the number of successes the higher the probability of failure of obtaining the modifier. Thomas is silent to wherein the higher the number of non-provided values of said first round, the higher the probability of obtaining said modifier of said second round, yet applicant's admission for having both embodiments makes obvious to this examiner that the inventor has two choices, have the probability got higher or lower with the increase of chances displayed, making the it a design choice with the limited number of permutations available to the inventor. It would have been obvious to on of ordinary skill at the time of the invention to decide to go higher, lower or equal when designing the invention.

**29. Examiner's Note:** Examiner has cited paragraphs and figures in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed

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invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK M. LEIVA whose telephone number is (571)272-2460. The examiner can normally be reached on M-Th 9:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (571) 272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

FML

05/10/2009

/Peter D. Vo/

Supervisory Patent Examiner, Art Unit 3714